

REMARKS

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 1 to 14, 17 and 19 to 28 are currently pending, claims 3 and 4 have been canceled, and claims 1, 19 and 26 have been amended.

The Office Action mailed March 2, 2004 addressed claims 1 to 14, 17 and 19 to 28. Claims 1 to 14, 17 and 19 to 28 were rejected.

Claims 1 to 14, 17 and 19 to 28 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the invention. The Examiner concluded that requiring the core layer to be free of density adjusting fillers is not clearly taught in the specification as filed.

Although Applicants respectfully disagree, in an effort to hasten prosecution, claims 1, 19 and 26 have been amended to delete the phrase free of density adjusting fillers from each of the claims. Claims 1, 19 and 26 have also been amended to claim that the center core material is a thermoplastic polymeric material. Applicants respectfully submit that this overcomes the rejection of claims 1 to 14, 17 and 19 to 28. Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claims 1 to 14, 17 and 26 to 28 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that it is unclear if all density adjusting fillers are being excluded from (i) or merely metal/metal alloys are being excluded.

As previously discussed, Applicants have amended claims 1, 19 and 26 to delete the requirement that the core layer is free from density adjusting fillers, therefore, this rejection is rendered moot. Applicants respectfully submit that this overcomes the rejection of claims 1 to 14, 17 and 26 to 28. Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claims 1 to 14, 17, 19 to 23, 25, 26 and 28 were rejected under 35 U.S.C. 102(b/e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Melvin '562.

Applicants respectfully submit that Melvin '562 does not disclose each and every element

of Applicants' invention, therefore, Applicants' claims 1 to 14, 17, 19 to 23, 25, 26 and 28 are not anticipated by Melvin '562.

Applicants respectfully submit that the reference, Melvin '562, qualifies as prior art under 35 U.S.C. § 102(e) for the § 103(a) rejection. Based upon the new revision to 35 U.S.C. § 103(c), commonly owned prior art which qualifies as prior art under 35 U.S.C. § 102(e) in a rejection under § 103(a) is no longer "prior art" against the claims of a commonly owned application if the application is filed after the effective date of the new rule.

Application Serial No. 09/840,475 and U.S. Patent No. 5,779,562 were, at the time the invention of Application Serial No. 09/840,475 was made, owned by Spalding Sports Worldwide, Inc. Both Application Serial No. 09/840,475 and U.S. Patent No. 5,779,562 are currently commonly owned by Callaway Golf Company.

Because the present application and the Melvin '562 reference are commonly owned and the present application was filed on April 23, 2001 (after November 29, 1999), Applicants respectfully submit that the Melvin '562 patent no longer qualifies as prior art against the claims.

For at least these reasons, Applicants respectfully submit that claims 1 to 14, 17, 19 to 23, 25, 26 and 28 are not anticipated by Melvin '562 under 35 U.S.C. § 102(b/e) or alternatively, are not obvious under 35 U.S.C. § 103(a) over Melvin '562. Applicants therefore respectfully request that the rejection of claims 1 to 14, 17, 19 to 23, 25, 26 and 28 be reconsidered and withdrawn.

Claims 1 to 14, 17 and 19 to 28 were rejected under 35 U.S.C. § 103(a) as obvious over Melvin '562 in view of Sullivan '119.

As discussed above, Applicants respectfully submit that the reference, Melvin '562, qualifies as prior art under 35 U.S.C. § 102(e) for the § 103(a) rejection. Based upon the new revision to 35 U.S.C. § 103(c), commonly owned prior art which qualifies as prior art under 35 U.S.C. § 102(e) in a rejection under § 103(a) is no longer "prior art" against the claims of a commonly owned application if the application is filed after the effective date of the new rule.

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Because the present application and the Melvin '562 reference are commonly owned and the present application was filed on April 23, 2001 (after November 29, 1999), Applicants respectfully submit that the Melvin '562 patent no longer qualifies as prior art against the claims.

For at least these reasons, Applicants respectfully submit that claims 1 to 14, 17 and 19 to 28 are not obvious under 35 U.S.C. § 103(a) over Melvin '562 in view of Sullivan '119. Applicants therefore respectfully request that the rejection of claims 1 to 14, 17 and 19 to 28 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 1 to 14, 17 and 19 to 28. Applicants respectfully request allowance of claims 1, 2, 5 to 14, 17 and 19 to 28, the claims currently pending.

Respectfully submitted,

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